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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/890,739 | 01/16/2002 | Gaute Munch | 2388-798 | 7866 |
| 29540 | 7590 | 11/24/2003 | EXAMINER | |
| PITNEY, HARDIN, KIPP & SZUCH LLP | | | CAPRON, AARON J | |
| 685 THIRD AVENUE | | | ART UNIT | |
| NEW YORK, NY 10017-4024 | | | PAPER NUMBER | |

3714

DATE MAILED: 11/24/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/890,739

Applicant(s)

MUNCH ET AL.

Examiner

Aaron J. Capron

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

This is a response to the Amendment received on September 17, 2003, in which claims 12-33 were added. Claims 1-33 are pending.

Claim Objections

Claims 3-9 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim must refer to the additional claims in the alternative only. See MPEP § 608.01(n). Accordingly, the claims 3-9 have been further treated based upon the best understanding of the Examiner.

Claim 10 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend upon other multiple dependent claims. See MPEP § 608.01(n). Accordingly, claim 10 has been further treated based upon the best understanding of the Examiner.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 6 and 10-11, 13, 17, 21-23, 28 and 32-33 are rejected under 35 U.S.C. 102(b) as being anticipated by Haugerud (U.S. Patent No. 4,712,184). This holding is maintained from

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prior action for cited claims, as amended, which is incorporated herein. Response to Applicant assertions is provided below and incorporated herein.

Referring to claim 1, Haugerud discloses a microprocessor controlled toy building element comprising a microprocessor which can execute instructions in the form of a program stored in a memory, the memory comprising subprograms which can be activated individually by specifying a list of subprogram calls (abstract); coupling means for coupling with building elements which can be moved by activation means, the activation means being controllable in response to the instructions (abstract), characterized by comprising communications means which can transmit the function calls to a second toy building element for programming of it (1:43-63, the toy parts are interchangeable and can create other additional toys using the same parts).

Referring to claim 6, Haugerud discloses a keyboard for manual entering of instructions (Figure 1).

Referring to claim 10, Haugerud discloses a first and second microprocessor controlled toy building elements (computer and remote control Lego device) where the second microprocessor controlled toy building element comprises a memory with subprograms which can be activated individually by receiving subprogram calls from the first toy building element.

Referring to claim 11, Haugerud discloses the first microprocessor controlled toy building element comprises operating means for making a program (computer) and that the second microprocessor controlled toy building element comprises operating means for activating just one of several programs (remote control Lego device).

Claims 13, 17 and 21-22 correspond in scope to a toy building element set forth for use of the toy building element listed in the claims above and are encompassed by use as set forth in the rejection above.

Claims 23, 28 and 32-33 correspond in scope to a toy building element set forth for use of the toy building element listed in the claims above and are encompassed by use as set forth in the rejection above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-5, 7-9, 14-16, 18-20, 24-27 and 29-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Haugerud et al. (U.S. Patent No. 4,712,184; hereafter "Haugerud") in view of Chainani et al. (U.S. Patent No. 5,724,074; hereafter "Chainani"). This holding is maintained from prior action for cited claims, as amended, which is incorporated herein. Response to Applicant assertions is provided below and incorporated herein.

Referring to claim 2, Haugerud discloses a microprocessor controlled toy building element, but does not disclose that the display incorporates icons to maneuver the toy building element. However, Chainani discloses a home computer in connection with a programmable toy that maneuvers the programmable toy by icons displayed on the personal computer (Figure 7) in

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order to allow children to program a toy microprocessor (1:57-64). The two references are analogous since both refer to controlling a programmable toy through the use of a personal computer. One would be motivated to combine the references in order to allow Haugerud's system to be more acceptable for a young child to program and maneuver the remote control device. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the maneuvering icons of Chainani into the device of Haugerud in order to be more acceptable for a young child to program and maneuver the remote control device.

Referring to claim 3, Haugerud and Chainani disclose instructions corresponding to one icon, implement a rule by controlling the activation means in response to signals from sensors connected to the toy building element.

Referring to claims 4-5 and 7, Haugerud and Chainani disclose a receiver for wireless reception of instructions (5:40-67)

Referring to claim 8, Haugerud and Chainani disclose the toy comprises communication means for transferring information via a light guide (Chainani: 5:40-67).

Referring to claim 9, Haugerud and Chainani disclose the toy comprises an elongated light guide through which visible light may be transmitted in its longitudinal direction, the light guide being adapted to allow part of the light transmitted to escape through its sides (Chainani: 5:40-67).

Claims 14-16 and 18-20 correspond in scope to a toy building element set forth for use of the toy building element listed in the claims above and are encompassed by use as set forth in the rejection above.

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Claims 24-27 and 29-31 correspond in scope to a toy building element set forth for use of the toy building element listed in the claims above and are encompassed by use as set forth in the rejection above.

Response to Arguments

Applicant's arguments filed September 17, 2003 have been fully considered but they are not persuasive.

Applicant argues that Haugerud reference does not disclose that the toy building element having a microprocessor and the transmission of programs from one unit to another. The claimed invention states, "a microprocessor controlled toy building element comprising a microprocessor...communication means which can transmit said function calls to a second toy building element for programming of it." However, Haugerud discloses having a computer with a keyboard for manual entering of instructions, wherein the computer has a microprocessor (Figure 1; 1:7-12) and that the computer can control other toys (1:43-63, the toy parts are interchangeable and can create other additional toys using the same parts). The Examiner views that the microprocessor controlled toy building element includes both the toy and the interface controlling the toy element. The claim language is not so limiting as to exclude the use of a toy building element and the interface that controls the toy building element. Therefore, the claimed invention fails to preclude the invention of Haugerud.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Galyean III et al. (USPN 6,290,565) discloses a toy building element being controlled by an interface via a wireless communication method.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron J. Capron whose telephone number is (703) 305-3520. The examiner can normally be reached on M-Th 8-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on (703) 308-1806. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

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JESSICA HARRISON
PRIMARY EXAMINER